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| 09/722,519 | 11/28/2000 | John S. Hendricks | 3960.D10 | 6858 |

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| EXAMINER | |
|---|---|
| CHAI, LONGBIT | |
| **ART UNIT** | **PAPER NUMBER** |
| 2131 | |

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/722,519 | HENDRICKS, JOHN S. | |
| | Examiner | Art Unit | |
| | Longbit Chai | 2131 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13 and 15-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

*1.* Claims 14 and 26 have been canceled; claims 1, 13 and 21have been amended in an amendment filed on 9/9/2005. Claims 1 – 13 and 15 – 25 have been examined.

### *Continued Examination Under 37 CFR 1.114*

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/2005 has been entered.

### *Claim Objections*

3. Claim 21 is objected to because of the following informalities: "from a remote operation center to a library" should be "from a remote operation center to the library". Appropriate correction is required.

Any other claims not addressed are objected by virtue of their dependency should also be corrected.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 13 and 17 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by MacPhail (Patent Number: 5089956).

As per claim 13, MacPhail teaches a method for processing text data for an electronic book in an electronic book home system comprising a library and viewer (MacPhail: see for example, Column 4 Line 41 – 57), the method, comprising:

receiving a packet of text data (MacPhail: see for example, Column 1 Line 38 – 49 and Column 4 Line 27 – 31: MacPhail discloses the benefits of electronic document processing can be realized from a network between a viewer and a library server);

determining whether the packet has a unique packet identifier (MacPhail: see for example, Column 1 Line 38 – 42, Column 4 Line 26 – 31 and Column 2 Line 61 – 63: each packet of the network must have a unique ID in order to transmit the indicated documents to the identified recipient end user such that the relationship of documents is maintained (Column 2 Line 61 – 63));

if the packet has a unique packet identifier, determining whether the packet identifier matches a library identifier of a library; and if the packet identifier matches the library identifier, storing the packet to a data file in a library storage (MacPhail: see for example, Column 4 Line 40 – 43: the server library performs various services such as for storing and retrieving documents electronically (Column 4 Line 41 – 42) and thereby the packet identifier must match the library identifier to assure the correct destination of electronic document delivery).

As per claim 17, MacPhail teaches determining whether the data file has been opened (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be opened before the data can be stored from the packet) , and

if the data file has been not been opened, opening the data file; and storing the packet to the data file (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be opened before the data can be stored from the packet).

As per claim 18, MacPhail teaches determining whether the packet is a final packet received for an electronic book (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be closed after the data written has been completed),

if the packet is the final packet, closing the data file; and updating a directory (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be closed after the data written has been completed).

As per claim 19, MacPhail teaches sending the data file to a viewer (MacPhail: see for example, Column 2 Line 60 – 64).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 – 11 and 21 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. (Patent Number: 5428529), in view of Choudhury et al. (Patent Number: 5509074).

As per claim 1, Hartrick teaches a method of communicating between components of a home subsystem comprising a home library for receiving and storing electronic books and a portable viewer for processing and displaying electronic books

(Hartrick: Column 1 Line 56 – 64: Hartrick discloses the electronic book can be used on a variety of display devices, Column 1 Line 56 – 57, and Official Notice is taken that the use of a hand-held based electronic book is one of the well-known techniques in the field and therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a portable viewer electronic book), the method comprising:

storing the data text in the viewer (Hartrick: Column 1 Line 51 – 64);

In the library, comparing a unique key associated with data text of an electronic book to a corresponding unique key of the viewer (Hartrick: Column 1 Line 65 – Column 2 Line 1, Column 4 Line 31 – 45 and Hartrick: Column 1 Line 56 – 64). Hartrick discloses using the password for security checking. However, Hartrick does not disclose expressly using the unique key for data protection.

Choudhury teaches in the library, comparing a unique key associated with data text of an electronic book to a corresponding unique key of the viewer (Choudhury: Column 1 Line 47 – 49: A on-line document server is equivalent to a document library of the home users and the copy-right server is used to impose appropriate forms of security treatment to authenticate the users for accessing the requested documents).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Choudhury within the system of Hartrick because (a) Hartrick discloses a problem of one-line electronic book system with the lack of adequate means to protect the documents and enforce the user's intentions for the treatment of his electronic books or documents (Hartrick: Column 1 Line 65 –

Column 2 Line 6) and (b) Choudhury further teaches an enhanced and improved security solution by using a copy-right server integrated with the document server (as an integrated one-line document library) to impose appropriate forms of security treatment to authenticate the users for accessing the requested documents (Choudhury: see for example, Column 2 Line 42 – 61).

If the comparing step produces a match, sending the data text related to an electronic book from the library to the viewer (Hartrick: Column 1 Line 65 – Column 2 Line 1, Column 4 Line 31 – 45 and Hartrick: Column 1 Line 56 – 64);

As per claim 2, Hartrick as modified teaches encrypting the data text (Choudhury: Column 2 Line 62 – 64).

As per claim 3 and 6, Hartrick as modified teaches preventing the viewer from outputing decrypted data text (Choudhury: Column 3 Line 10 – 11 and Column 4 Line 31 – 32).

As per claim 4 and 7, Hartrick as modified teaches displaying the data text on a display portion of the viewer; and decrypting the data text as the data text is displayed (Choudhury: Column 3 Line 44 – 45 and Column 4 Line 25 – 31: Choudhury teaches once the displayer receives the encrypted document, the device decrypts it and displays it (Column 4 Line 25 – 26). Examiner notes the device (either screen displayer or printer) must use microprogram memory buffer (or memory page) to perform the

functions of decrypting and displaying electronic documents and accommodate the screen display buffer / page one at a time).

As per claim 5, Hartrick as modified teaches preventing the viewer from outputting decompressed data text (Choudhury: Column 6 Line 15 – 17).

As per claim 8, Hartrick as modified teaches the data text is encrypted and compressed when it is received by the viewer, and further comprising decompressing and decrypting a portion of the data text (Choudhury: Column 6 Line 15 – 17).

As per claim 9, Hartrick as modified teaches encrypting and compressing the data text before it is sent to the viewer, and further comprising decompressing and decrypting the data text one page at a time, as a current page is displayed on the viewer (Choudhury: Column 3 Line 44 – 45 and Column 4 Line 25 – 31: Choudhury teaches once the displayer receives the encrypted document, the device decrypts it and displays it (Column 4 Line 25 – 26). Examiner notes the device (either screen displayer or printer) must use microprogram memory buffer (or memory page) to perform the functions of decrypting and displaying electronic documents and accommodate the screen display buffer / page one at a time).

As per claim 10, Hartrick as modified teaches the viewer has a unique key for decrypting the data text, whereby only one viewer can access a particular transmission of data text (Choudhury: Column 1 Line 46 – 61).

As per claim 11, Hartrick as modified teaches the data text is transmitted as a digital bit stream (Choudhury: Column 2 Line 2 Line 58).

As per claim 21, Hartrick teaches a method for processing data text for electronic books in a home library comprising a library and a viewer (Hartrick: Column 1 Line 56 – 64: Hartrick discloses a on-line electronic book system), the method, comprising:

sending the packet to a viewer communicatively coupled to the library (Hartrick: Column 1 Line 51 – 57);

Hartrick discloses using the password for security checking. However, Hartrick does not disclose expressly encrypting and compressing the packet.

Choudhury teaches encrypting and compressing the packet (Choudhury: see for example, Column 1 Line 43 – 61);

Choudhury teaches encrypting and compressing the packet (Choudhury: see for example, Column 1 Line 43 – 61: A on-line document server is equivalent to a document library of the home users and the copy-right server is used to impose appropriate forms of security treatment to authenticate the users for accessing the requested documents).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Choudhury within the system of Hartrick because (a) Hartrick discloses a problem of one-line electronic book system with the lack of adequate means to protect the documents and enforce the user's intentions for the treatment of his electronic books or documents (Hartrick: Column 1 Line 65 – Column 2 Line 6) and (b) Choudhury further teaches an enhanced and improved security solution by using a copy-right server integrated with the document server (as an integrated one-line document library) to impose appropriate forms of security treatment to authenticate the users for accessing the requested documents (Choudhury: see for example, Column 2 Line 42 – 61).

sending a packet of data text from a remote operations center to a library (Choudhury: see for example, Column 1 Line 37 and Figure 1 Element 3 discloses the electronic document networking techniques. Copyright Server and Document Server are qualified to serve as the remote operations center and the document library respectively. The user is qualified as a viewer. The necessity of networking techniques, shown in Figure 1, depends upon the close physical proximity between the source and destination entities);

storing the packet in a viewer storage (Choudhury: see for example, Column 1 Line 43 – 61);

decompressing and decrypting the packet, comprising decompressing and decrypting an electronic book by page, just before a page is displayed on the display of the viewer (Choudhury: see for example, Column 3 Line 44 – 45 and Column 4 Line 25

– 31: Choudhury teaches once the displayer receives the encrypted document, the device decrypts it and displays it (Column 4 Line 25 – 26). Examiner notes the device (either screen displayer or printer) must use microprogram memory buffer (or memory page) to perform the functions of decrypting and displaying electronic documents and accommodate the screen display buffer / page one at a time);

displaying the data text on a display of the viewer (Choudhury: see for example, Column 3 Line 44 – 45 and Column 4 Line 25 – 31).

As per claim 22, Hartrick as modified teaches storing the packet to a data file in the library, which data file is capable of storing a plurality of packets related to an electronic book (Choudhury: see for example, Column 1 Line 43 – 61).

As per claim 23, Hartrick as modified teaches encrypting and compressing the packet comprises encrypting and compressing the data file, and wherein the step of sending the packet to the viewer comprises sending the data file to the viewer (Choudhury: see for example, Column 1 Line 43 – 61).

As per claim 24, Hartrick as modified teaches the data packet is sent in a bit stream having a packet identifier, and further comprising comparing a packet identifier with a library identifier, and wherein the step of sending the packet to the library comprises sending the packet to the library if the packet identifier matches the library identifier (Choudhury: see for example, Column 1 Line 43 – 61).

As per claim 25, Hartrick as modified teaches decompressing and decrypting the data file comprises using a security key unique to the viewer (Choudhury: see for example, Column 1 Line 46).

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), in view of Choudhury (Patent Number: 5509074).

As per claim 20, MacPhail does not teach encrypting and compressing the data file.

Choudhury teaches encrypting and compressing the packet (Choudhury: see for example, Column 1 Line 43 – 61: A on-line document server is equivalent to a document library of the home users and the copy-right server is used to impose appropriate forms of security treatment to authenticate the users for accessing the requested documents).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Choudhury within the system of MacPhail because Choudhury teaches an enhanced and improved security mechanism for on-line document server systems by using a copy-right server integrated with the document server (as an integrated one-line document library) to impose appropriate forms of security treatment to authenticate the users for accessing the requested documents (Choudhury: see for example, Column 2 Line 42 – 61).

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. (Patent Number: 5428529), in view of Choudhury (Patent Number: 5509074), and in view of Boulton (Patent Number: 4985697).

As per claim 12, Hartrick as modified does not teach the data text is transmitted from a remote cable headend to the library and bundled into a data file, which data file is sent to the viewer.

Boulton teaches the data text is transmitted from a remote cable headend to the library and bundled into a data file, which data file is sent to the viewer (Boulton: see for example, Column 10 Line 63 – 65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Boulton within the system of Hartrick as modified because Boulton teaches a cable TV transmission technique for electronic book applications.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), in view of Boulton (Patent Number: 4985697).

As per claim 15, MacPhail does not teach the packet is transmitted as a digital bit stream from a remote cable headend to the library.

Boulton teaches the packet is transmitted as a digital bit stream from a remote cable headend to the library (Boulton: see for example, Column 10 Line 63 – 65).

Same rationale of combination applies here as above in rejecting the claim 12.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), in view of Feigenbaum (Patent Number: 4644470).

As per claim 16, MacPhail does not teach if the packet does not have a unique packet identifier, storing the packet to an electronic message file.

Feigenbaum teaches if the packet does not have a unique packet identifier, storing the packet to an electronic message file (Feigenbaum: see for example, Column 4 Line 45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Feigenbaum within the system of MacPhail because Feigenbaum teaches a method of allowing data processing systems to adopt names on either a unique or non-unique basis, which would in effect be transparent to the user if it is a non-unique name for broadcast messages (Feigenbaum: see for example, Column 2 Line 21 – 24 and Column 2 Line 13 – 15).

## ***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Shwarts et al. (U.S. Patent Number 6,243,071) discloses "Tool Set for Navigating Through an Electronic Book".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai
Examiner
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